



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,848	01/11/2002	Vincent Millot	34284	4174

116 7590 04/02/2004

PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

EXAMINER

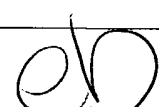
SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,848	Applicant(s) MILLOT ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 14, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) 9, 12-13, 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections are overcome by applicants' amendment filed 1/26/04.

The following rejection is non-final based on the use of a new reference against the present claims, namely, SU 1509388.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 1 has been amended to recite "solvent ionisable species". The scope of the claim is confusing because it is not clear what is meant by "solvent ionisable species". As set forth on page 8, lines 19-21 and page 12, lines 17-26 of the present specification, it appears that while the ink contains ionisable species, it is not the solvent. That is, the ink contains both solvent and ionisable species wherein it is the solvent which dissociates the ionisable species. Thus, it is not clear why the solvent is referred to as the ionisable species in claim 1. If the examiner is correct in that the ink contains solvent and ionisable species, it is suggested that in line 5 after "solvent", the phrase "ionisable species" is deleted and that in line 9 after "dissociate", "the" is deleted to provide proper antecedent basis.

(b) Claim 4 recites “glycol alkylene ethers and esters”. The scope of the claim is confusing because it is not clear what is being claimed. Does this refer to alkylene glycol ether and alkylene glycol ester? As set forth on page 15, lines 3-12, it appears that the claim is referring to both “alkylene glycol ethers” and “alkylene glycol ether esters”. If this correct, it is suggested that the claim is amended accordingly.

(c) Claim 5 recites “monoalkylic ethers with 1 to 6 carbon atoms in each alkyl group, alkylene glycols with 1 to 10 carbon atoms”. The scope of the claim is confusing due to the use of the comma between “group” and “alkylene” because it is not clear if this refers to ethers and alkylene glycols or ethers of alkylene glycols. In light of the disclosure in claim 4, on which claim 5 depends, of “glycol alkylene ethers” and on page 15, line 3 of the present specification, it is suggested that the comma between “group” and “alkylene” be changed to “of”.

(d) Claim 5 recites “esters of the ethers and the alkylene glycols”. The scope of the claim is confusing because it is not clear what is being claimed. From the claim, it appears that esters of ethers and esters of alkylene glycols are being claimed. However, in light of the disclosure on page 15, line 8, of “glycol ether esters”, it is suggested that the phrase “esters of the ethers and the alkylene glycols” is changed to “esters of the alkylene glycol ethers”.

(e) Claim 10 recites “in which the said solvent(s) and/or pigment(s) are chosen from dyes and pigments”. It is not clear how solvents are chosen from dyes and pigments. Should “solvent(s)” be changed to “dye(s)”?

(f) Claim 17 recites “propolymer glycol”. The scope of the claim is confusing because it is not clear what is meant by this phrase. Should the phrase be changed to “propylene glycol”?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8, 10-11, 14-15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by SU 1509388 taken in view of the evidence in *The Printing Ink Manual*.

Pending translation, it is noted that SU 1509388 discloses composition comprising 2-3% nigrosine dye, 4-6% binder which is methacrylic acid/methyl methacrylate copolymer, 40-50% dioxolane, 6-7% glycerol, and the balance ethanol wherein the ethanol can dissociate ionisable species. There is also disclosed a process wherein the composition is applied to object. It is well known, as found in *The Printing Ink Manual* (page 207), that nigrosine dyes are types of Solvent dyes.

SU 1509388 discloses that the composition is a paint. While there is no disclosure that the composition is an ink as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended

use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art structure which is a composition identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that SU 1509388 anticipates the present claims.

Allowable Subject Matter

6. Claims 9, 12-13, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

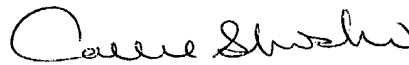
Claims 9, 12-13, and 16 would be allowable if rewritten in independent form given that there is no disclosure in SU 1509388 of plastifier, conductivity salt, or marking process wherein the marking is achieved by continuous deflected ink jet as presently claimed.

Art Unit: 1714

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
3/30/04